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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4208-4028

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Typed or printed name _____

Application Number

09/990,038

Filed

November 20, 2001

First Named Inventor

Mika Grundstrom

Art Unit

2144

Examiner

Shaw, Peeling Andy

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. Registration number 56,641

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June 30, 2006

Registration number if acting under 37 CFR 1.34 _____

Date

Signature

Elliot L. Frank

Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

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Docket No. 4208-4028

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Mika Grundström

Group Art Unit: 2144

Serial No.: 09/990,039

Examiner: Shaw, Peling Andy

Filed: November 20, 2001

For: MULTICAST ADDRESS TO PACKET IDENTIFIER MAPPING

REMARKS BY APPLICANTS FOR CONSIDERATION IN THE
PRE-APPEAL CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Prior to submitting an Appeal Brief, Applicants now submit remarks regarding the Final Office Action now pending for the above-identified application. This document is submitted concurrently with a Pre-Appeal Conference Request Form and a Notice of Appeal. Applicants respectfully request consideration of the following remarks in addition to the Requests for Reconsideration already of record in the file.

I. Status of the Claims:

Claims 1-112 are pending in the application. Claims 1-3, 5, 7-13, 15, 17-23, 25, 27-30, 63-64, 66, 68-72, 74, 76-80, 82, 84-86 and 111-112 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. 6,216,167 B1 to Momirov (hereafter “Momirov”). Claims 4, 6, 14, 16, 24, 26, 65, 67, 73, 75, 81, 83 and 109 are rejected under 35 U.S.C. § 103(a) to Momirov in view of U.S. 6,226,291 B1 to Chauvel et al. (hereafter, “Chauvel”).

II. Final rejection not appropriate:

The Manual of Patent Examining Procedure (MPEP) states in section 706.07 that, "Before final rejection is in order a clear issue should be developed between the examiner and applicant." Applicants respectfully assert that the Examiner has not appropriately considered the arguments in the November 30, 2005, amendment, and did not adequately reject new claims 111 and 112, rendering the March 3, 2006, Final Office Action both non-responsive and premature. The details of this assertion are found in Applicant's May 26, 2006, Request for Reconsideration.

III. Claim 1 is not anticipated by Momirov:

Claim 1 recites the following:

1. A method for constructing a data packet having both a payload segment that carries data associated with a link layer (MAC) or network layer (IP) address and a header segment that has one or more fields, the method comprising:
 - generating an address value based on the IP or MAC address;
 - formatting the address value; and
 - populating the formatted address value into a field of the header that will be used as a selection criteria by a receiving terminal.

The Examiner contends that claim 1 is anticipated by Momirov. Applicants respectfully disagree. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Momirov is a system for routing information to various output queues or "taps" within a network device (column 1, lines 11-16). A standard packet is separated into "cells," and each cell receives forwarding control information regarding a particular output tap in the networking device. This information is then used to reassemble a packet prior to forwarding to an I/O card for broadcast. Momirov utilizes cross reference tables in routing data. The abstract recites, "The data and the multicast group identifier are then transferred to a switching card which indexes into a first set of correlation data...", and "the I/O cards identify a set of ports associated with the multicast group by indexing into a second set of correlation data..." The concept of "index" (e.g., address) to "data" correlation is understood by one of ordinary skill in the art as a cross

reference table. This interpretation is also supported later in the abstract: “Correlation data, e.g., in the form of tables indexed by multicast group identifiers...” Further, Momirov states, “The egress path table 315 is typically used by the switching logic 310 during egress processing to determine upon which tap(s) a particular multicast cell is to be forwarded.” (column 5, line 6)

Applicants have clearly shown that Momirov does not disclose each and every element of the claimed invention. The Examiner makes broad rejections based on “the object” of the invention. These rejections do not fulfill the Examiner’s requirement to clearly set forth how the relied upon reference anticipates each and every limitation in the claims. Claim 1 recites at least the “construction” of a data packet that includes both a header and a payload segment, wherein the header segment has an address value created through a “generating” process based on the IP or MAC address. The generated address information in the header will be used as selection criteria by a “receiving terminal.” As opposed to Momirov as previously described, claim 1 includes at least two major distinguishable aspects: construction and generation of header address information, and data packet selection at a receiving terminal using header information.

“Constructing a data packet,” is distinguishable from forwarding a data packet as performed by the Momirov system. Momirov packets are only “prepended and/or appended” (see, for example, col. 8, lines 31-34). As best understood, the Momirov system places a new header in front or behind the packet, containing the routing information. The original packet structure is untouched. Thus, the IP address will still be included if the arriving packet was an IP packet. In at least one embodiment of the present invention as claimed, such a header field may be constructed, modified, determined and/or compiled into a single header (e.g., specification ¶¶ 0038-0040), which is distinguishable from the teaching in Momirov.

Momirov is further deficient in that it deals with routing only within one device. The device has multiple output ports, and the problem solved is to determine the output ports to which the (multicast) data shall be routed (see, for example, FIG. 1, reference items 105-108). The evaluation of the “multicast identifier” is done completely within the same device. In at least one embodiment of the present invention, the task is independent of the number of output ports, and the new “address value” is evaluated in a different device (e.g., a receiving terminal as recited in claim 1), which stands apart from the device which generates the address value.

Further, it is not apparent how other limitations in the claims, for example claims 8 and 9, are allegedly anticipated by Momirov. There is no recitation or implication in Momirov that the

IP or MAC address, or a subset thereof, has been operated upon by a bitwise logic function or a hashing function. Momirov column 10, line 27-column 11, line 8 merely discusses different formats for a packet address, and column 2, lines 14-55 is a generalized summary of the invention, and does not recite or imply the use of hashing with respect to the present invention.

Applicants have continued to argue throughout all their responses that typical multicast systems may experience delays in delivering information to a client terminal caused by the need for client device to access various cross-reference tables in order to determine the appropriate selection criteria for data packets corresponding to information desired by a receiving terminal. The present invention causes additional IP, MAC and other protocol related information to be included in the packet header so that the receiving terminal may use the header as a selection criteria without having to access cross reference tables, thereby reducing network overhead. Applicants intended to further distinguish the claimed subject matter, and expedite prosecution, by including these elements in claims 111 and 112 added in the November 30, 2005, response.

The rejection in the Final Office Action grouped claims 111 and 112 with the other claims that the Examiner considered to be within the same scope as previously pending claims 1-3, 5 and 7-10 without any further explanation (March 3, 2006, Office Action, page 5, section 3i). The Examiner did not respond to Applicants explicit statement supporting the novelty of new claims 111 and 112, and has not provided an adequate grounds of rejection to claims that Applicants believe to include limitations distinct from both the previously presented claims and the previously cited references. The Examiner attempted to justify the rejection in the advisory action by saying the claims, having limitations not found in any other claim (selection criteria is based only [on] the formatted address value, and that selection criteria is established without the use of tables) were within the scope of the other claims based on the disclosure. The Examiner's assertion was not understood, and Applicants continue to hold these claims untreated.

IV. 35 U.S.C. § 103(a) Rejections are deficient:

Applicants respectfully contend that all of the obviousness rejections in the prior Office Actions lack adequate motivation as required under US patent law due to impermissible hindsight, and that the obviousness rejections are also deficient for at least the reasons stated above, and for the deficiencies noted in the November 30, 2005, Request for Reconsideration.

CONCLUSION

Based on the foregoing amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the Final Office Action in the above-identified application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4503, Order No. 4208-4028. A DUPLICATE OF THIS SHEET IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4503, Order No. 4208-4028. A DUPLICATE OF THIS SHEET IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: June 30, 2006 By:


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